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Remarks

The Applicant has carefully read and reviewed the Office Action mailed October 12, 2004, and the references cited therewith. Claims 1-5, 7-16, and 18-20 were rejected. Claims 6 and 17 were objected to. Claims 18-20 have been canceled in this response. Claims 1-17 are still pending.

Claim Rejections – 35 USC 102

Claims 8 and 13-16 were rejected under 35 USC 102(b) as being anticipated by Jardine et al.(US 4,958,125). Claim 8 is an independent claim and claims 13-16 depend from claim 8. Applicant respectfully traverses the rejection of claims 8 and 13-16.

As is well known, for a prior art to anticipate under 35 U.S.C. § 102(b), the prior art has to meet every element of the claimed invention. Claim 8 clearly claims "A rotating disc data storage device balancer." Jardine discloses a rotating drill string; nowhere in Jardine is there even a reference to a data storage device. Therefore, claim 8 and claims 13-16, which depend from claim 8, are distinguishable from Jardine.

Claim Rejections – 35 USC 103

Claims 1-5, 7, 9-12, and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jardine in view of Cobern (US 4,647,853). Claims 18-20 have been canceled in this response. Claims 2-5 and 7 depend from independent claim 1. Claims 9-12 depend from independent claim 8.

Applicant respectfully traverses the rejection of claims 1-5, 7, and 9-12. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Claim 1 clearly claims "a timing sensor adapted to detect an instantaneous speed of the rotating member and *triggering the data acquisition member to begin sampling when the rotating member is rotating.*" (emphasis added) Nowhere in Jardine or Cobern is there a suggestion that

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there is a sensor that triggers the data acquisition member to begin sampling. Therefore, Claim 1 is allowable over Jardine in view of Cobern. Claims 2-5, 7, and 9-12 are allowable as dependent claims providing additional limitations to allowable independent claims.

Claims Objections

The Applicant appreciates the recognition of allowable subject matter of claims 6 and 17 if rewritten in independent form.

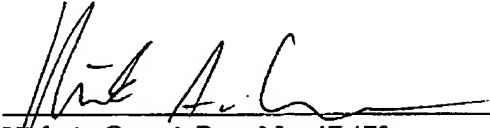
Conclusion

For these reasons, claims 1-17 are believed to be patentable over the prior art of record, therefore, reconsideration and withdrawal of the rejection or objection of claims 1-17 is requested.

Applicant respectfully asserts that the present claims particularly point out and distinctly claim the subject matter which is regarded as the invention.

Therefore, it is respectfully submitted that the pending claims are in condition for allowance, and favorable action with respect to the present application is requested.

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